

REMARKS

Claims 1-7, 9-6, 28-34, 36-53, 55-61, 63-80 and 82 are pending in the present application. Claims 1, 28, 55, and 82 were amended; and no claims were added. Support for the amendments to the claims can be found in the specification at least on pages 12-15. Reconsideration of the claims is respectfully requested.

I. Examiner Interview

Applicant thanks Examiner Boutah for all the courtesies extended to Applicant's representative during the November 4, 2005 telephone interview. During the interview, Applicant's representative discussed the prior art of record and the manner in which the presently claimed invention is distinguishable over the prior art of reference. The Examiner agreed that an amendment to independent claim 1 clarifying who is determining whether a communication is deleted without being opened, as well as the amendment to claim 82 to further clarify the claimed "counter" would overcome the cited prior art references. The arguments discussed as well as additional reasons that the claims are not obvious in view of the cited prior art references are set forth in the remarks below.

II. 35 U.S.C. § 103, Obviousness: Claims 1-7, 9-26, 28-34, 36-53, 55-61 and 63-80

The examiner has rejected claims 1-7, 9-26, 28-34, 36-53, 55-61 and 63-80 under 35 U.S.C. § 103(a) as being unpatentable over *Paul, System and Method for Filtering Unsolicited Electronic Mail Messages Using Data Matching and Heuristic Processing*, U.S. Patent No. 5,999,932, December 7, 1999 (hereinafter "*Paul*") in view of *Ogilvie et al., Self-Removing Email Verified or Designated as such by a Message Distributor for the Convenience of a Recipient*, U.S. Patent No. 6,324,569, November 27, 2001 (hereinafter "*Ogilvie*"). This rejection is respectfully traversed.

The examiner states on pages 2-4 of the Office Action dated August 22, 2005 that:

(Amended) Regarding claim 1, Paul teaches a method in a data processing system for marking particular types of communications, said method comprising the steps of:

establishing a database of a plurality of different distinguishing identifiers, wherein each of said plurality of identifiers identifies a

particular type of communication (figure 1: 102; col. 1, lines 9-20; col. 3, lines 37-52);

receiving a communication (abstract; col. 3, lines 54-64);

determining if said communication includes one of said plurality of different identifiers (abstract; col. 2, lines 20-30);

marking said communication responsive to a determination that said communication does include one of said plurality of different identifiers (abstract; col. 2, lines 40-47; col. 3, line 66 to col. 4, line 11);

forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers (col. 8, lines 55-67); and

storing said identifier as one of said plurality of identifiers in said database (col. 8, lines 55-67).

However, Paul fails to explicitly teach: determining whether said communication was deleted without being opened; and determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened.

Ogilvie teaches: determining whether said communication was deleted without being opened (col. 6, lines 21-24); and determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened (col. 5, lines 27-45).

At the time the invention was made, one of ordinary skill in the art would have been motivated to combine the teaching of Ogilvie with the teaching of Paul in order to provide control over message removal therefore lessen burden off of recipients (Ogilvie: col. 2, lines 14- 22).

Office Action dated August 22, 2005, pages 2-4.

A. The examiner bears the burden of establishing a *prima facie* case of obviousness.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

i. All claim limitations must be considered, especially when missing from the prior art.

Paul and *Ogilvie* do not show all features of the claims. See *In Re Lowry*, 32 F.3d 1579. In comparing *Paul* and *Ogilvie* to the claimed invention, the claim limitations of the presently claimed invention may not be ignored in an obviousness determination. Amended independent

claim 1, which is representative of other rejected independent claims 28, and 55 with respect to similarly recited subject matter, claims as follows:

1. A computer implemented method in a data processing system for marking particular types of communications, said method comprising the steps of:
 - establishing a database of a plurality of different distinguishing identifiers, wherein each of said plurality of identifiers identifies a particular type of communication;
 - receiving a communication;
 - determining, by the computer system, if said communication includes one of said plurality of different identifiers;
 - marking said communication responsive to a determination that said communication does include one of said plurality of different identifiers;
 - forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers;
 - determining, by the computer system, whether said communication was deleted without being opened;
 - determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened; and
 - storing said identifier as one of said plurality of identifiers in said database.

Paul and *Ogilvie* fail to teach or disclose "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers; determining, by said computer system, whether said communication was deleted without being opened;" and "determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened," as is now recited in amended claim 1.

The cited references do not teach or disclose "determining, by said computer system, whether said communication was deleted without being opened" and "determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened," as is recited in amended claim 1. The Examiner acknowledges that *Paul* fails to teach this feature. However, the Examiner believes that *Ogilvie* teaches this feature at column 6, lines 21-24 and column 5, lines 27-45. *Ogilvie* teaches as follows:

Methods, articles, signals, and systems are provided for providing email message originators and distributors with default control over message removal at a message recipient's location, regardless of whether the message has been opened. For instance, a self-removing message is designated as such by the message's

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originator, and a self-removal enhancement is added to conventional message content before the message is transmitted over a computer network toward one or more recipients. At the recipient's location, the message is automatically deleted without additional effort by the recipient, before or after being displayed, according to the originator's instructions unless they are overridden by the recipient. ISPs and other message distributors may identify messages that should be self-removing, and make them self-removing if they are not. Thus, the burden of removing unsolicited email messages is transferred from recipients to the system and the message's originators and/or to ISPs and other email distributors. Security of messages may also be enhanced.

Ogilvie, abstract.

Ogilvie merely teaches an email message originator creating a self-removing email message that will automatically delete without any effort by the recipient. A self-removing message can be created and transmitted to recipients. The message will delete automatically unless overridden by the recipient. *Ogilvie* teaches that a self-removing message is automatically deleted according to the message originator's instructions. *Ogilvie* creates the instructions that will control when the message will automatically delete at a message originator, rather than determining whether the communication "was deleted without being opened" by a computer system receiving the communication from a message originator. In fact, *Ogilvie* does not teach or even mention determining whether a message was deleted without being opened.

In fact, *Ogilvie* is completely unconcerned with whether an email message is opened or unopened when it is deleted. *Ogilvie* teaches a self-removing email is "automatically deleted without additional effort by the recipient, before or after being displayed, according to the message originator's instructions." *Ogilvie* also teaches:

the message 206 is to be deleted automatically by the removal code 208 from each recipient's mailbox/inbox no later than a specified time after being received, regardless of whether it has been opened by that recipient;

Ogilvie, column 6, lines 21-24.

Here, *Ogilvie* teaches that a self-removing message is deleted automatically "regardless of whether it has been opened by that recipient". *Id.* Because *Ogilvie* teaches that a self-removing message is deleted regardless of whether it is opened or unopened, a determination as to whether a communication was deleted without being opened would be unnecessary. In

contradistinction, the presently claimed invention claims "determining, by said computer system, whether said communication was deleted without being opened."

Moreover, *Ogilvie* fails to teach "determining an identifier included within said communication" in response to determining that the communication was deleted without being opened. *Ogilvie* merely teaches creating a self-removing message that automatically deletes rather than determining an identifier included within a communication that was deleted without being opened. *Ogilvie* teaches as follows:

In addition to the message self-removal code 208 in the message 206 and/or elsewhere, the message 206 often includes one or more self-removal indicators 210 such as bitflags, header values, file name extensions, or other data marking the message 206, thereby identifying the entire message 206 or a portion thereof to the removal code 208 and distinguishing the 206 from messages which are not subject to removal by the means taught herein. Of course, in a system where all messages are entirely self-removing, the indicators 210 are optional unless they are needed to detail information such as how long to display the message contents to the recipient, whether to allow recipients to scroll back through a previously displayed portion of the message contents, and so on. However, batch files, message handling rules, and other deletion controls that are provided by the recipient 202 are not indicators 210, since they do not give originators 200 and/or distributors 222 the responsibility for, and the initial control over, removal of messages at the recipient's location.

Ogilvie, column 5, lines 27-45.

As shown above, *Ogilvie* merely teaches self-removing messages include self-removal codes and/or self-removal indicators. The indicators can detail information such as how long to display the message contents to the recipient and whether to allow recipients to scroll back through a previously displayed portion of the message contents. However, *Ogilvie* does not teach or disclose determining an identifier included within a communication that was deleted without being opened, in this or any other section of the reference.

The references also fail to teach or disclose "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers," as is claimed in independent claim 1. The Examiner believes this feature is taught by *Paul* at column 8, lines 55-67. *Paul* teaches as follows:

If no matches of the "FROM," "TO," "CC," "BCC," or "SUBJECT" field data are identified in step 403 of FIG. 4 or steps 404 to 406 of FIG. 4A, in step 412 the e-mail filter performs one or more heuristic processes to determine whether the

received e-mail message meets certain criteria suggesting that the message may be of interest to the user. If the e-mail message meets one or more of the heuristic criteria, in step 413 the e-mail is marked with a second display code indicating that the status of the message is "NEW." The "1 TO," "FROM" and "SUBJECT" field data from the e-mail message may optionally be added to the user inclusion list by the inclusion list processor (e.g., 102 or 302) as shown [sic] in step 414.

Paul, column 8, lines 55-67.

Here, *Paul* merely teaches that if no match is found between message data and inclusion list data, a heuristic process is performed on message data to determine if the message is of interest to the user. The message is marked "NEW" if the message meets heuristic criteria. Field data from the message, such as field data from the "TO" or "FROM" field may be added to an inclusion list. However, *Paul* does not teach forwarding the message. To the contrary, a message in which no match is found between message data and inclusion list data processed further and marked with a second or third display code rather than forwarding the communication. In contradistinction, the presently claimed invention in claim 1 recites "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers." Therefore, the cited references fail to teach or disclose all of the features recited in independent claim 1.

Ogilvie fails to teach or disclose "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers; determining, by said computer system, whether said communication was deleted without being opened" and "determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened." Such features are not taught or suggested by either *Paul* or *Ogilvie*. Thus, *Ogilvie* cannot make up for the deficiencies of *Paul*. Therefore, amended independent claim 1 is not obvious over *Paul* in view of *Ogilvie* because the features believed to be disclosed by these references are not present.

ii. **The proposed combination does not result in the present invention.**

The present invention is directed towards marking communications that include an identifier and determining an identifier included within the communication if the communication was deleted without being opened. *Paul* merely teaches marking email messages if the message data matches identification data in a user inclusion list and processing message data using a heuristic process to determine if message data is of interest to a user.

Paul teaches as follows:

A system for eliminating unsolicited electronic mail generates and stores a user inclusion list including identification data for identifying e-mail desired by the user. Data from one or more fields of incoming electronic mail messages are compared with the identification data stored in the user inclusion list. If the electronic mail message data matches corresponding identification data from the user inclusion list, the e-mail message is marked with a first display code, such as "OK." If no match is detected, the system performs at least one heuristic process to determine whether the electronic mail message may be of interest to the user. If the message satisfies one or more criteria as determined by the heuristic process and is therefore of potential interest to the user, the message is marked with a second display code, such as "NEW." If the e-mail message does not satisfy any of the heuristic criteria, the e-mail message does not satisfy any of the heuristic criteria, the e-mail message may be marked with a third display code, such as "JUNK." The processed e-mail messages are displayed to the user in a display mode corresponding to the display codes respectively assigned to the messages.

Paul, abstract.

As discussed above, *Paul* merely teaches marking messages if a match is found between message data and user inclusion list data. If no match is found, *Paul* teaches performing a heuristic process on message data to determine if the message is of interest to the user, and mark the message accordingly. *Paul* does not teach or suggest determining if a message was deleted without being opened or determining an identifier in a message that was deleted without being opened. Moreover, as discussed above, *Ogilvie* is directed towards creating self-removing messages that automatically delete according to the message originators instructions. *Ogilvie* does not teach or suggest determining if a message was deleted without being opened or determining an identifier within the message that was deleted without being opened. Therefore, even if *Paul* and *Ogilvie* could be properly combined, a combination of the references would not form the presently claimed invention in claim.

Instead, a combination of *Paul* and *Ogilvie* would result in marking a message with a first display code if it contains message data that matches data in a user inclusion list, marking the message with a second display code if it is determined to be of interest to the user, marking the message with a third display code if the message is not identified as being of interest to the user, and wherein the message will automatically delete itself regardless of whether the recipient opens the message or does not open the message, according to the instructions of a message originator. The combination of *Paul* and *Ogilvie* would not result in determining, by a computer system

receiving the communication, if the communication was deleted without being opened and determining an identifier included within the communication, in response to determining that the message was deleted without being opened, as is claimed in the presently claimed invention in amended independent claim 1.

B. A proper *prima facie* case of obviousness must be supported by some teaching or suggestion contained in the prior art.

A proper *prima facie* case of obviousness must be supported by some teaching or suggestion contained in the combined references. In making an obviousness determination, one cannot pick and choose among the individual elements or assorted prior art references to recreate the claimed invention. *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 U.S.P.Q.2d 1241 (Fed. Cir. 1991). Instead, whether the prior art made obvious the invention must be determined by looking for some teaching or suggestion in the references to support their use in the particular claimed invention. *Id.* Applicant respectfully submits that the references cited cannot be combined to produce the claimed invention because "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination." *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987)(emphasis added).

Paul does not give any teaching, suggestion, or incentive to determine whether a communication was deleted without being opened as in the presently claimed invention. *Paul* teaches sorting messages by determining if message data matches data in a user inclusion list and sorting messages that do not contain matching data using a heuristic process. *Paul* marks messages with a display code such as "OK," "NEW," or "JUNK." See *Paul*, abstract. *Paul* is only concerned with sorting messages and marking messages that match user inclusion data and marking messages to indicate whether a message is determined to be of interest to a user. *Paul* is unconcerned with whether a message is opened or deleted without being opened. *Paul* does not provide any teaching or suggestion to determine if a communication is deleted without being opened or to determine an identifier included in a communication that was deleted without being opened.

Furthermore, nowhere does *Ogilvie* teach, suggest, or give any incentive to determine if a communication was deleted without being opened or to determine an identifier in the

communication in response to determining that the communication was deleted without being opened. To the contrary, as shown above, *Ogilvie* only teaches a self-removal code or a self-removal indicator for use in creating a self-removing message that will automatically delete itself regardless of whether the message has been opened or unopened. *Ogilvie* offers absolutely no teaching, suggestion, or motivation for determining whether a communication is deleted without being opened because the status of a message as being opened or unopened when a message is deleted is irrelevant to *Ogilvie*. Therefore, the Examiner has failed to point out a teaching, suggestion, or incentive in the prior art to determine whether a communication was deleted without being opened and determine an identifier included within the communication in response to determining that the communication was deleted without being opened.

C. Stating that it is obvious to try or make a combination or modification without a suggestion in the prior art is not *prima facie* obviousness.

The references do not provide a suggestion or motivation for the proposed modification. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. at 687. The Examiner believes that one of ordinary skill in the art would have been motivated to combine the teachings of *Paul* with the teachings of *Ogilvie* to provide control over message removal and therefore lessen the burden off of recipients.

Ogilvie teaches:

Accordingly, it would be an advancement to provide an improved approach to email and similar messaging which moves the email message disposal burden off the shoulders of the recipient. In particular and without limitation, it would be an advance to make public notices and news sent through email less onerous to recipients, and likewise to make email advertisements (including without limitation coupons, contact information, descriptions of goods and/or services, comparisons, and promotional materials) available to multiple recipients without requiring that recipients affirmatively remove unwanted advertisements from their computer systems or create a reply message having REMOVE or another keyword in the subject, to indicate their lack of interest in the subject matter being advertised.

Ogilvie, column 2, lines 14-22.

Here, *Ogilvie* merely teaches that the burden of disposing of messages can be removed from a recipient. However, such teachings do not teach, suggest, or motivate determining

whether a communication was deleted without being opened or determining an identifier included within the communication that was deleted without being opened. Therefore, the references do not provide any motivation to combine the references. Furthermore, even if one of ordinary skill could have been motivated to combine the teachings of *Paul* and *Ogilvie*, the references would not have motivated one of ordinary skill in the art to both combine and modify the references as would be necessary in order to reach the presently claimed invention in claim 1.

In fact, *Ogilvie* actually teaches away from the presently claimed invention since *Ogilvie* directs one to create a self-removing message that will automatically delete itself in accordance with the message originators instructions regardless of whether the message is opened or unopened by a message recipient rather than determining, by said computer system, whether a communication was deleted without being opened as in the claimed invention. See *In re Hedges*, 228 U.S.P.Q. 685 (Fed. Cir. 1986).

Furthermore, *Paul* teaches away from the presently claimed invention where *Paul* teaches one of ordinary skill in the art to sort messages using a heuristic process if no match is made between message data and the user inclusion list data is found, rather than forwarding the communication if the communication does not include an identifier, determining if the communication was deleted without being opened, and determining an identifier included within the communication that was deleted without being opened. To the contrary, *Paul* teaches:

If the e-mail filter 104 does not detect a match between the stored inclusion list data and the data from the received email message, the incoming e-mail is further processed using one or more heuristic processing techniques to determine whether the e-mail may of interest to the user. The filtering process and the heuristic process will be described in further detail below. If the e-mail message satisfies one or more criteria as determined with the heuristic processing, the e-mail message is marked with a second display code. If the data in the e-mail message do not match the data in the inclusion list and if the message also does not satisfy the heuristic processing criteria, then the message is marked with a third display code.

Ogilvie, paragraph 4, lines 12-25.

Paul describes sorting and marking messages using a heuristic process if not match is found between message data and inclusion list data to indicate if the message is of interest to the user, rather than forwarding the communication and determining an identifier included within the communication if the communication was deleted without being opened. Thus, one of ordinary

skill in the art would not be motivated to combine the references to reach the presently claimed invention.

D. The presently claimed invention may be reached only though an improper use of the disclosed invention as a template to piece together and modify the prior art.

Moreover, the examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, *Paul* and *Morin* cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of applicant's disclosure a model for the needed changes.

The Examiner has failed to state a *prima facie* case of obviousness as to amended independent claim 1. Therefore, amended independent claim 1 is allowable over the cited prior art. Independent claims 28 and 55 recite subject matter addressed above with regard to independent claim 1. Moreover, amended claim 28 recites a computer system comprising means for performing the determining features of claim 28. Therefore, independent claim 28 is not unclear as to who is doing the determination. Thus, independent claims 28 and 55 are allowable over *Paul* and *Ogilvie* under the same rationale set forth above with regard to independent claim 1.

E. Dependent Claims

At least by virtue of their dependency on independent claims 1, 28, and 55, dependent claims 1-7, 9-26, 28-34, 36-53, 55-61, and 63-80 are allowable over the prior art of reference. Moreover, dependent claims 1-7, 9-26, 28-34, 36-53, 55-61, and 63-80 recite other combinations of features not taught or suggested by the prior art.

For example, dependent claims 7, 34, and 61 claim "deleting marked communications before said marked communications are forwarded to their intended recipients." The Examiner believes this feature is taught by *Paul* at column 5, lines 18-32. *Paul* teaches:

In addition to automatically adding new e-mail source addresses to the inclusion list, the list processor 201 may also optionally delete old addresses from the inclusion list. For example, the list processor 201 may be programmed to delete an e-mail address from the inclusion list when the e-mail address is not stored in the user's address book, buddy list or personal manager and has not appeared in the user's inbox or outbox for a predetermined period of time, such as a month. The user may also be prompted to delete an inclusion list entry as a result of the user's deletion of an entry from the user's inbox, outbox, address book, buddy list or personal manager. The functionality of list processor 201 may be accomplished using known programming techniques as would be apparent to one of skill in the art.

Paul, column 5, lines 18-32.

Here, *Paul* merely teaches updating a user's inclusion list. Inclusion list data may be updated by deleting old addresses from the inclusion list when, for example, the address has not appeared in the user's inbox or outbox for a predetermined time period. The user may also be prompted to delete an inclusion list entry in response to a user deleting an entry from the user's inbox or outbox. Thus, *Paul* is merely teaching deleting a listing in a user inclusion list. *Paul* does not teach or suggest "deleting marked communications before said marked communications are forwarded to their intended recipients," as is claimed in dependent claims 7, 34, and 61. Therefore, dependent claims 7, 34, and 61 are not obvious in view of the prior art of reference.

As to dependent claims 20, 47, and 74, the Examiner believes that *Paul* teaches establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a particular language at column 9, lines 7-19 which teaches as follows:

E-mail messages are displayed to the user in a display format determined by their display codes (step 415). For example, "OK," "NEW" and "JUNK" messages may be displayed in different colors to indicate their different status. Other possible display modes include: a) no modification b) changing the subject line to reflect the status such as changing "Make money FAST!" to "JUNK: Make money FAST!"; c) changing font or appearance of the message subject line to reflect its status; or d) placing the message in a folder based on its status (or other modes as are known in the art). The present invention contemplates numerous display options for the different types of e-mail messages which are apparent to those of skill in the art.

Paul, column 9, lines 7-19.

As shown above, *Paul* merely describes different formats for marking a message. A message can be marked or displayed with different font colors, changing subject line, etc. However, the cited portion of *Paul* does not teach or suggest that an identifier identifies a particular language. To the contrary, the cited portion of *Paul* does not discuss identifiers, an user inclusion list, inclusion list data, or identification data or any kind. Therefore, *Paul* does not teach or disclose the features believed to be present in the references. Thus, claims 20, 47, and 74 are not obvious in view of the cited references.

III. 35 U.S.C. § 103, Obviousness: Claim 82

The examiner has rejected claim 82 under 35 U.S.C. § 103(a) as being unpatentable over *Paul* in view of *Ogilvie*, in further view of *Morin* et al., System and Method to Control Sending of Unsolicited Communications Relating to a Plurality of Listings in a Network-Based Commerce Facility, U.S. Patent Publication No. 2005/0144238, June 30, 2005¹. This rejection is respectfully traversed.

The examiner states on page 11 of the Office Action dated August 22, 2005 that:

(New) Claim 82 is similar to claim 1, further including a step of: incrementing a counter associated with a sender of a communication including an identifier stored in said database of identifiers, in which is not taught in the Paul or the Ogilvie references. However, this is taught in Morin in paragraphs 0041 and 0043. At the time the invention was made, one of ordinary skill in the art would have been motivated to combine the teaching of Morin with the teachings of Paul and Ogilvie in order to keep track of the number messages received, therefore ensuring that the number of unsolicited messages is under control.

Office Action dated August 22, 2005, page 11.

Amended independent claim 82 recites subject matter addressed above with regard to independent claims 1, 28, and 55. Therefore, independent claim 82 is allowable over the prior art of reference under the same rationale as is set forth above with regard to independent claims 1, 28, and 55. In addition, amended independent claim 82 claims "incrementing a counter associated with a sender of said communication including said identifier stored in said database of identifiers, wherein said counter can be used to identify a sender who often sends unwanted

¹ This application is a continuation of application no. 09/982,415, filed on October 17, 2001, now U.S. Patent No. 6,748,422

communications." The Examiner acknowledges that this feature is not taught by *Paul* or *Ogilvie*. However, the Examiner believes this feature is taught by *Morin* at paragraphs 0041 and 0043. *Morin* teaches the following:

A user (block 311) who has been blocked from using the feature that allows forwarding of non-transactional e-mails, and that has been reinstated (e.g., 30 days have elapsed as shown in block 312), is allowed to use the feature again. The system 10 re-starts the complaint counter (block 313) and the user will be able to resume use of the feature (block 314). The same triggers, actions, and impacts (blocks 315, 316, 317, etc.) apply to the reinstated user (block 311) (i.e., one who has previously been suspended from the system 10 for SPAM) as to the new user (block 301) of the system 10. Of course, it should be appreciated that the triggers, actions, and impacts described in the embodiment illustrated by FIG. 6 are flexible. For example, in another embodiment the sanctions against a new user (block 301) may be entirely different (e.g., more stringent) than the sanctions implemented against a reinstated user (block 311).

Morin, paragraph 0041.

This section of *Morin* teaches a complaint counter that can be re-started when a user that was previously blocked from forwarding non-transactional e-mails is allowed to forward non-transactional e-mails again. *Morin* does not teach or suggest incrementing a counter associated with a sender of said communication including an identifier stored in said database of identifiers, as is claimed in amended independent claim 82. *Morin* also teaches:

Referring now to FIG. 7B there is shown a diagram of the user-to-user non-transactional flow of FIG. 7A including implementation of a SPAM prevention feature. As in FIG. 7A, the user clicks on the User ID (block 401) and signs in (block 402). However, in the flow diagram of FIG. 7B, the system 10 queries whether or not this user is a SPAM abuser (block 422) by searching the complaint counter in the user table illustrated by FIG. 3 herein. For example, a database management system in the database server that operates with a known database language such as structured query language (SQL) may be used manage, store, and retrieve information from the user table regarding SPAM complaints against a user (see FIG. 2). The system 10 checks how many complaints have been associated with the user's account. If the SPAM counter for the user is past a given threshold, the user is unable to access the contact from 100 for non-transactional communications (block 423) and is thus prevented from contacting the intended recipient. If the user is not a SPAM abuser, the user may proceed to open the contact form 100 (block 403), and proceed through the steps previously described in FIG. 7A (blocks 404, 405, 406, etc.). If, the recipient wants to report SPAM, the user clicks on a link (block 435) and logs in with a user ID (block 436). The complaint form 200 (see FIG. 5) opens (block 437). The user may

classify the complaint as SPAM and submit the complaint (block 438). The on-line service documents the report in the sender's file and sends a notice to the sender (block 439) (see FIG. 6). The system 10 is then queried to see if the SPAM trigger should be tripped (e.g., if the user has reached a threshold where the user has accumulated a certain number of SPAM complaints)(block 440). If the answer to the query is "yes", then the user's account and further user of the contact form 100 will be prevented (block 442). If the answer is "no," then the user's account is updated so that the SPAM rating is displayed during the user's next user of the system 10 (block 441) and the process is complete (block 443).

Morin, paragraph 0043.

Again, *Morin* merely teaches a complaint counter that can be checked to determine how many SPAM complaints have been associated with a user's account. However, *Morin* fails to teach or suggest "incrementing a counter associated with a sender of said communication including an identifier stored in said database of identifiers, wherein said counter can be used to identify a sender who often sends unwanted communication," as is claimed in claim 82.

In addition, *Morin* does not teach or suggest "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers; determining, by the computer system, whether said communication was deleted without being opened" and "determining an identifier included within said communication responsive to a determination that said communication was deleted without being opened," as is recited in amended independent claim 82. Thus, *Morin* fails to make up for the deficiencies of *Paul* and *Ogilvie*. Therefore, claim 82 is not obvious in view of *Paul*, *Ogilvie*, and *Morin* because the features believed to be disclosed by these cited references are not present.

Moreover, *Morin* does not give any teaching, suggestion, or incentive to forward a communication responsive to a determination that the communication does not include one of a plurality of different identifiers, determine whether a communication was deleted without being opened, determine an identifier included within said communication in response to determining that said communication was deleted without being opened, and increment a counter associated with a sender of a communication including an identifier stored in a database of identifiers as in the presently claimed invention in claim 82. In contradistinction, *Morin* teaches controlling the sending of unsolicited communications by incrementing a SPAM complaint counter associated with a sender of unsolicited communications. *Morin* teaches:

A system and method to control sending of unsolicited communications over a network is provided. Typically, the network is the Internet and the system defines a SPAM prevention tool for users of an on-line service, such as an on-line bidding service. Users may contact an intended recipient with a contact form, which is forwarded to the recipient's e-mail address by an on-line service provider. A link accessible from a Web site allows recipients of unsolicited e-mail to complain to the on-line service provider. Sanctions are implemented against the sender of unsolicited e-mail based on the frequency of complaints. When the complaint level against a sender reaches a certain threshold, the sender is unable to user the contact form fro a predetermined time period.

Morin, abstract.

As shown above, the complaint counter is incremented to keep track of the number of complaints against a sender. Sanctions are implemented against the sender of the SPAM when the number of complaints reaches a certain threshold. Thus, *Morin* is only concerned with tracking the number of complaints made by a recipient of email messages against a sender of email messages. *Morin* is not concerned with the content of the email messages or the number of email messages sent that include an identifier in the communication. Therefore, *Morin* cannot teach, suggest, or motivate incrementing a counter for the sender of a communication including an identifier, as is claimed in independent claim 82.

Furthermore, *Morin* teaches away from the presently claimed invention in claim 82 where *Morin* teaches controlling the sending of unwanted email by tracking SPAM complaints and blocking a sender with a certain threshold of complaints from sending unsolicited email for a predetermined time period rather than determining if a communication was deleted without being opened and determining an identifier included within the communication in response to determining that the communication was deleted without opening. As discussed above, *Morin* is unconcerned with whether an email message includes an identifier and whether the email message was deleted by a recipient without being opened. As discussed above, *Morin* is only concerned with the number of complaints made by recipients of email messages against a particular sender of the email messages.

Morin does not teach or suggest all of the features recited in amended independent claim 82. Thus, *Morin* cannot make up for the deficiencies of *Paul* and *Ogilvie*. Claim 82 is not obvious in view of *Paul*, *Ogilvie*, and *Morin*. Therefore, the rejection of claim 82 under 35 U.S.C. § 103(a) has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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